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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,956	10/02/2000	Danne L. Buchanan	7905.15.1	4478
22428	7590	11/26/2003	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Applicati n N .

09/676,956

Applicant(s)

BUCHANAN ET AL.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is the answer to the communication filed on October 2, 2000, which paper has been placed of record in the file.
2. Claims 1-26 are pending in this application.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on May 31, 2001, is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 8, 14, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Geer, U.S. Patent No. 5,930,778.

Regarding to claim 1, Geer discloses a method for processing a check deposited at a non-maker bank remote-capture site, remote-capture site capable of interfacing with a financial institution (column 6, lines 25-37, the paper check deposited at the payee's location remote from the payee's depository bank), without forwarding the original check to a maker bank (column 7, lines 62-67, the paper check is not forwarded

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to the payment system; column 9, lines 50, the payment system transmits the electronic check to the maker bank), method comprising the steps of:

converting check into electronic check data at remote-capture site (column 6, lines 40-45, paper check is converted into electronic form at the payee's location);

electronically exchanging check data with financial institution (column 9, lines 10-13, the electronic check is transmitted from the payee's location to the depository bank); and

financial institution crediting an account according to check data without referencing original check (column 9, lines 15-18, the depository bank credits the payee's account; column 7, lines 25-29, the paper checks are not forward to the depository bank).

Regarding to claim 8, Geer further discloses converting step further comprises the step of: scanning at remote-capture site check to create image data, image data representing an electronic image of check, remote-capture site being a Magnetic Ink Character Recognition (MICR) system; reading at remote-capture site image data to create informational data from image data to aid in electronic processing of deposited check; and reading at least a portion of check to determine additional informational data stored in a Magnetic Ink Character Recognition (MICR) line(column 7, lines 44-50 and column 8, lines 10-25).

Claims 14, 21 are written in computer-readable medium, that parallel limitation as found in claims 1, 8 discussed above, therefore are rejected by the same rationale.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9-13, 15-20, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer, U.S. Patent No. 5,930,778.

Regarding to claim 2, Geer further discloses converting step comprises the steps of: scanning at remote-capture site check to create image data, image data representing an electronic image of check; and reading at remote-capture site image data to create informational data from image data to aid in electronic processing of deposited check (column 8, lines 10-25). Geer does not disclose remote-capture site being a lock box system for performing the method of Geer, Geer discloses remote-capture site is payee's location. However, lock box system is well known in the art of processing checks (also see Geer, column 3, line 55-column 4, line 18). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the method of Geer's for the lock box system for purpose of time consuming because it eliminates the transferring of the paper checks.

Regarding to claims 3, 9, Geer further discloses electronically exchanging check data step comprises the steps of: sending check data from non-financial institution location to financial institution over an electronic channel (column 9, lines 10-12, sending electronic check from payee's location to the depository bank); financial institution verifying check data with account records accessible by financial institution; when check data conforms to account records (column 9, lines 13-18, the depository bank credit payee's account). Geer does not teach financial institution confirming check data to remote location; non-financial institution location processing check data into processed check data in response to confirming step. However, such processes are well known in the art of processing checks. Therefore, it would have been obvious to

one with ordinary skill in the art at the time the invention was made to include the features above with Geer's for the purpose of getting the confirmation from the bank before the payee's location process the check.

Regarding to claims 4, 10, Geer discloses financial institution acknowledging to remote location receipt and accuracy of check data, and financial institution sending acknowledgement of accurate receipt of check data to remote location (column 15, lines 20-27, payee's location communicates with depository bank for verification of transmission and receipt of information).

Regarding to claims 5, 11, Geer discloses remote location secondly converting processed check data into electronic processed check data (column 8, lines 10-27; column 9, lines 1-10, column 10, lines 1-7, converting processed check data into electronic processed check data by scanning processed check to create image data, image data representing an electronic image of processed check and reading image data to create informational data from image data to aid in electronic processing of depositing of check, secondly electronically exchanging processed check data with financial institution by sending processed check data from remote location to financial institution over an electronic channel, financial institution verifying processed check data with account records accessible by financial institution; and when processed check data conforms to account records, financial institution secondly confirming processed check data to remote location).

Regarding to claims 6, 12, Geer discloses crediting account according to check data step further comprises the step of: when financial institution is not the maker bank of check, sending processed check data to maker bank for clearing check (column 9, lines 22-25, 37-50).

Regarding to claims 7, 13, Geer further discloses sending processed check data to maker bank for clearing check step comprises the steps of: when maker bank is electronic exchange-capable, electronically exchanging processed check data with maker bank (column 9, lines 37-50). Geer does not disclose when maker bank is not electronic exchange-capable, printing a facsimile of check from processed check data; and forwarding facsimile of check to maker bank. However, Geer teaches electronic image of the check is stored for retrieval purposes (column 13, lines 45-50). Moreover, communication via the facsimile is old and well-known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Geer's for the purpose of allowing the maker bank still to receive the processed checks via facsimile when the maker bank does not have the electronic exchange capability such as electronic mail exchange or Internet connection.

Claims 15-20, 22-26 are written in computer-readable medium, that parallel limitation as found in claims 2-7, 9-13 discussed above, therefore are rejected by the same rationale.

### ***Conclusion***

8. Claims **1-26** are rejected.

9. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Carlson et al (US 5,053,607) discloses check processing device for processing paper checks at point of sale terminal.

Braun et al (US 4,321,672) discloses methods and system for effecting electronic funds transfer transaction based upon the use of unit records.

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Campbell et al (5,373,550) discloses the method of transmitting of check images via public switched telephone network.

Cahill et al (US 5,940,844) discloses method and apparatus for displaying electronic image of a check.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label "PROPOSED" or "DRAFT").




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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

A handwritten signature in cursive script, appearing to read 'Nga B. Nguyen', written in black ink.

November 17, 2003